

No. 2915.

IN THE
United States Circuit Court of Appeals ✓
FOR THE NINTH CIRCUIT

CENTRAL CALIFORNIA CANNERIES CO.,
Appellant,

vs.

THE DUNKLEY COMPANY,
Appellee.

REPLY BRIEF OF APPELLEE

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Defendants-Appellants, } In Equity
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DUNKLEY COMPANY,
Plaintiff-Appellee.

REPLY BRIEF ON BEHALF OF APPELLEE.

By F. L. CHAPPELL.

PERJURY CHARGES AGAINST PLAINTIFF'S WITNESSES.

According to defendants-appellants' statements *all* of the witnesses on behalf of plaintiff-appellee have committed perjury, and defendants-appellants have asked that the machinery of the government be made use of to investigate these charges.

A reference to the opinion of Judge Van Fleet in the court below and a reference to the record shows nothing indicating anything of the kind nor any grounds for such statements. While we view it that

findings of fact of the court below are unassailable in this court, in view of the recent Supreme Court decision of *Adamson vs. Gilliland*, we feel, in view of the more or less fervid statements of appellant's counsel, like bringing such matters to the attention of the court in brief detail.

It is said that the Dunkleys are guilty because they have changed their testimony from that given in the Dunkley-Beekhuis interference. Also that Schau is a liar and a perjurer because he was only 19 years old, that being the only reason, or at least the best reason, assigned for charging Schau with the crime of perjury.

Defendants-appellants in their brief have printed the decisions of the Patent Office and of the Court of Appeals of the District of Columbia in the Beekhuis-Dunkley interference case. We find at p. 237 of that brief the solemn finding by the Court of Appeals of the District of Columbia:

“Dunkley was the first to invent and put into practice a rapid and effective machine for peeling peaches.”

See the beginning of the paragraph at the top of page 237.

At p. 239 of the brief appears the statement of the Examiner of Interferences indicating that Dunkley conceived the invention a year in advance of Beekhuis, in August, 1902, and that he disclosed the same in September, 1902, while Beekhuis disclosed his in-

vention in July, 1903; and there is given as the date of reduction to practice by Dunkley, July, 1903, and Beekhuis, February, 1904.

This statement, which could not have been varied by the testimony in the Interference, because it is a pleading on which the interference was founded, is entirely supported by the evidence in the record before this court. The evidence in the Interference case, consisting of a large group of witnesses, shows that the first successful reduction to practice was in July, 1903. At that time the machine was completely organized and successfully operated.

The peach-peeling season is brief. Not much can be accomplished between seasons except to theorize and organize a machine for a test as soon as peaches can be obtained the following season. Dunkley was busy, not merely with this invention but with many others. He turned the matter over to his son who organized the structure and was able to peel a few peaches late in 1902 with a machine that was not completely organized. The peaches were poured into the machine from a pan and collected in a tub. The spray part was tested sufficiently so that he was very much impressed with it, and peaches were peeled with it.

In the April following, 1903, a lye tank was purchased, and the machine was organized. Harvey Schau saw it in Kalamazoo about the 4th of July, 1903, and immediately thereafter saw the whole thing

set up and in operation in South Haven, where it was operated through that season.

But, however, it was not until the season of 1904 that *all* peaches at the plant of the Dunkley Company were peeled by this method. A considerable part of the peaches canned by that company in South Haven in 1903 were peeled by hand or with a St. Clair-Scott machine.

It was the privilege of defendants-appellants to have introduced a certified copy of the record in the Interference to show what was proved there, if they wished to attack what was proved in this case, because of the alleged difference.

They did not offer that record. They attempted a sort of sharp practice by quizzing about an isolated portion here and another portion there, and they now wish to explain the very different things proven here from those which were proven in the Interference proceeding.

The proofs in the Interference proceeding are not here. Defendants did not dare to offer them in their entirety, because the numerous witnesses there sworn entirely support the dates that are fixed here, as counsel for defendants-appellants very well knows. However, plaintiff-appellee was not at liberty to prove its case in that way, but was obliged to bring three witnesses from Michigan, 2500 miles, for that purpose. It is submitted that three witnesses are entirely suf-

ficient. Two witnesses only are required in some criminal cases.

At this point we desire to protest against the course of defendants' counsel in constantly and continuously referring to matters which are not in the record. A particularly objectionable instance of this is the cut opposite page 134 of the brief, which purports to illustrate the friction gears and the manner of mounting them on the original Dunkley machine, Plaintiff's Exhibit 10. No such drawing was put in evidence. It is purely a mythical drawing, apparently originating in the imagination of counsel. We protest against its use here.

Plaintiff-appellee is savagely criticized for lack of documentary proofs. The real evidence, Plaintiff's Exhibit No. 10, the machine itself or so much of it as is left, is offered in evidence and identified positively by all three witnesses. An examination of that frame, Plaintiff's Exhibit No. 10, will show, as Campbell himself swears, that it was made of pieces picked up around the plant. Where, as there, a great variety of inventions was proceeding, much material would necessarily be on hand, and it would be quite impossible by the examination of bills and statements to determine just what the 4x4's were for, and an examination of the bearing boxes will show that they were not boxes purchased for this particular purpose, because the oil cup is pointed off at an angle, showing that material was picked up around the shop from

which to organize this structure, and there would be no bill. And had there been any bill, it would not have been specified that the material was for a peach-peeling machine.

Again, the plant of the Dunkley Company has been disorganized. All the peach trees in that region were killed by a severe freeze, and in 1907 it was necessary, as pointed out by Melville Dunkley, to ship peaches to South Haven for canning. When it is remembered that South Haven was the center of the peach-growing country of Michigan, this statement would be hard to believe, but it is the fact. Books and records had been scattered and were therefore not obtainable. The factory had burned. But, as above pointed out, if obtained they would likely show nothing as to the first machine, Plaintiff's Exhibit No. 10.

But it appears by S. J. Dunkley, by his son Melville Dunkley, and also by the witness H. C. Schau that immediately the first machine was tested in July, 1903, materials were purchased for other and larger machines, and it is quite likely that for those machines material would be especially purchased. All of which would be in accord with statements made by Stewart Campbell, as confirmed by Brunker. These were for the second machine, a three-line machine of large capacity.

The testimony of the witnesses that is criticized does not depart from the preliminary statement above

quoted, which shows long activity conforming to the statements that the invention was conceived in August, 1902. See the testimony of Melville E. Dunkley at R., p. 416. He tells of an experiment early in the peach-peeling season of 1902, and says:

"The machine such as outlined is practically the same as the one standing here, and we started in getting ready to put that machine together in the early part of 1902. The season, of course, was very busy and I was back and forth from Hartford so that the machine was not finished until toward the late fall of 1902; we got perhaps a few bushels of peaches through there using an ordinary galvanized tub and a basket of some kind to scald a few bushels of peaches in order to get work enough done to see whether the matter was going to be practical or not. We, however, were very well satisfied with the results and in the following spring we started to finish the machine, ordering the parts for the scalder, prevaricator we called it. That was built and set up with this first experimental machine at South Haven in the early summer of 1903. Later that year there was another machine built and put in operation."

On p. 418 the witness says:

"A. The first complete machine including the scalder and the peeler was operated in South Haven in 1903. The scalder was delivered in April, I believe, of 1903 and the machine was set up at South Haven as soon after that as we could get to it, and we started practical operations on that line as soon as the Georgia peaches came into the market at Chicago, which is usually early in July."

"Q. Then you would fix the date for the first successful operation as when?

"A. In *July, 1903*, for the commercial operation of the machine."

and the *spray part* of the machine was operated effectively "in the *fall of 1902*."

The date given by Melville Dunkley is fixed by a letter about the purchase of the tank, the letter being marked Plaintiff's Exhibit 8, and appears at R., p. 741. His testimony relative thereto appears at R., p. 467-8.

Samuel J. Dunkley confirms this. He says, R., p. 479:

"A. August, 1902, I told my son about the matter and we made some experiments and concluded it would be worth while to build a little experimenting machine to try it out; so I gave him the instructions and then the machine was finished and hooked up and we tried it; I put up some canned goods, a few cases and the next spring was satisfied that it was all right and then we went ahead and built the apparatus which is practically the same as at the present time.

"THE COURT—Q. The next spring, what year would that be?

"A. 1903. In *July, 1903*, the apparatus was completed and tried out—about *July 15*, that is, when the southern peaches got up.

"MR. CHAPPELL—Q. What month was that complete apparatus tried out of what year?

"A. July 15, 1903."

But it transpires that Plaintiff's Exhibit 10 had been set up the fall before, but it did not constitute the complete machine. It lacked the tank, etc. There was immediately after July, 1903, put up a three-line machine. See the complete testimony at R., p. 484.

Harvey Schau, who is criticized for testifying because he was only 19 years old at the time, testifies at R., p. 513 as to the circumstances of his employment. He says at R., p. 514:

"A. Until 1903 they were peeled by hand or by a little hand machine; *beginning* in 1903 they commenced to use what we called a *lye process*; beginning in 1904 the peaches were *all* peeled by the lye process."

When called upon to state what he knew, on the same page he says:

"A. I saw an experiment with some peaches in a wire waste-paper basket in July, 1902."

"A. I left South Haven in the first of August, 1902, and went to Hartford, and I was there until the 1st of November; the first of November I came back to South Haven, and there was installed in the basement of the north wing some machines that I had never seen before and one of these was as I was afterwards informed—was a machine for peeling peaches.

"THE COURT—Q. What date was that?

"A. The 1st day of November, 1902. I am very certain of that date because I was paid by the month then—I got paid twice a month and when I came to leave Hartford I was financially short and my check had not come and I had to

wait and make arrangements to postpone some payments until I got my check which came two or three days afterwards at South Haven.

"MR. CHAPPELL—Q. Do you know what became of the machine that you observed in November, 1902?

"A. I think it is still in existence; I know it is still in existence."

"A. Early in the next summer I was working in South Haven but my home was in Kalamazoo, and I made trips to Kalamazoo as often as I could, and on one of these trips I stopped in that factory in the morning before going to the train and they showed me an outline; they had some machines completed and some of them were in the course of completion, the whole line.

"THE COURT—Q. What time was this?

"A. I think that was either the day before or the day after the 4th of July.

"Q. 1903?

"A. Yes.

"MR. CHAPPELL—Q. What next did you observe after that as to the lye-peeling process?

"A. Soon after this the whole plant was moved to South Haven and it was operated at the beginning of the peach season in 1903."

And he identified the machine which he saw in November, 1902, as Plaintiff's Exhibit No. 10 (R., 515).

The proofs of plaintiff are therefore very clear and strong. The trial court was justified in accepting them. The testimony offered and the showing made of the Vernon machine shows it to be a different machine explained in the opinion. The Grier machine

was not in existence until after the date of Dunkley's conception and after the date of Dunkley's reduction to practice. The proofs show that it was not in use until August, 1903. It is doubtful if the statements there made are the fact, as we view it, but as they did not anticipate the Dunkley date it was unnecessary to take on the burden of attacking these statements.

We have deemed it best to refer specifically to this testimony in view of the violent attack of counsel for defendants-appellants. We can realize very well that counsel is very much overwrought from having lost a very important case. We submit, however, that he has not analyzed the situation dispassionately, as has the Judge below, and that his attacks on the witnesses and on the court below are wholly unwarranted and not justified under all the circumstances.

We will not discuss here his vituperation against plaintiff's counsel, further than to say that it is wholly uncalled for and would seem to indicate a lack of experience in matters of this kind. There is no perjury.

BURDEN OF PROOF.

Defendants-appellants urge that Grier was the prior inventor of the structure of the patent in suit. They state that Grier conceived the invention in the summer of 1902. Grier swears, using the language: "I conceived the idea right then—" (R., p. 305). This

is merely stating a conclusion of his and there is absolutely no proof that he conceived anything and none of the witnesses called to show that he conceived anything, established any facts in that behalf.

The proofs tend to show that in August, 1903, he produced a machine that would peel peaches. We have very grave doubts that he did this, but as Dunkley was earlier than that, having conceived his invention as proved in August, 1902, the frame of the machine having been identified as produced immediately thereafter and having been seen by Schau after it was set up as well as by the two Dunkleys, the question of diligence or priority of reduction to practice does not arise.

Dunkley was very actively engaged and he successfully operated his complete machine early in July, 1903, previous to Grier.

There is no law that Grier has any rights before he actually produced his machine. The Constitution of the United States says, Article I, Sec. 8: "Congress "has power to promote the progress of science and "useful arts, by securing for a limited time to inventors the exclusive right to their respective discoveries."

The inventors referred to here are those that Congress is seeking to protect and they are the only persons who have any right to their inventions at the date of conception. The inventor who does not seek the protection of the Patent Office can only rely on the

date when he completes the invention, so far as any decision has ever been rendered and so far as any citation of authority here is concerned. Where there have been rival inventors they are inventors who are seeking the protection of their inventions by patent from the United States Patent Office.

This is so well recognized that Macomber in "The Fixed Law of Patents" at Sec. 808, gives the general statement on the question of priority. He says:

"Priority is a question arising between two pending applications, a pending application and an issued patent, or between two issued patents. The first two conditions are subject for an interference proceedings; the third is a condition which may be met either by an action under 4918 R. S. (see Interfering Patents, Sec. 587), or it may be met and settled in an action for infringement. The subject of interference has been considered under Secs. 582-585."

There are no decisions considering the details of the development of an invention except there be (1) two applicants for a patent, (2) an applicant for a patent and a patentee, or (3) two patentees, as indicated. In all other cases of anticipation and of prior use the only thing that is up for consideration is the completed production of the article in question. There is no protection for an inventor during the development of his invention that he does not intend to patent; because it is clear that only patented inven-

tions and their development are contemplated to be protected.

It is a safe assumption that if an inventor does not consider his invention of sufficient value to apply for a patent within the time prescribed by law, he has produced no invention of value or anything that the public would be interested in.

However, this more or less interesting question does not arise in the case at bar. Dunkley, as appears by the proofs, conceived his invention first and had it finished first, and that puts an end to the entire question, as will be seen by a reference to the proofs.

While it is not a requirement under the conditions of this case, the proofs have been beyond a reasonable doubt, on the positive oath of three witnesses who identify the machine itself and not some document or picture relating to it. But it is clear that, as inventors are entitled to exploit an invention for any period under two years before applying for a patent, they would only be required to prove by a preponderance of the evidence any use of theirs within this limited period.

A review of the decisions under the heading "Burden of proof" at page 15 of the brief on behalf of defendants-appellants is therefore wholly unnecessary. The question is not here.

We submit that the rule of law laid down by the Supreme Court in the recent decision referred to in

the main brief, of *Adamson vs. Gilliland*, is conclusive and should apply here on the questions of fact.

It seems unnecessary to add anything further to the brief already filed herein where the discussion is as complete as need be.

Respectfully submitted.

FRED L. CHAPPELL,
Counsel for Appellee.

SEPARATE BRIEF BY JOHN L. MILLER.

Preliminarily we can not refrain from calling the Court's attention to the violent tone and intemperate language of defendants' brief. Its author appears to be actuated by personal animosity. He charges perjury by plaintiff's witnesses, intentional misrepresentation and bad faith of counsel, and makes veiled insinuations and innuendoes against the learned Judge of the lower court. While we are well aware that such matters will have no influence with the Court in arriving at a just decision of the case, yet we can not permit the occasion to pass without voicing our disapproval of the course pursued. Such matters are out of place in the argument of grave questions of law before a judicial tribunal, especially a tribunal of such august character as this Court, and we can only attribute this lapse from the proprieties to the uncontrolled passions of a disappointed litigant. Possibly after passion has subsided and calmness prevails counsel may see the error of their way.

Another matter we venture to note is the copious reference in defendants' brief to matters *dehors* the record. Purported quotations from the proceedings in the Patent Office and the briefs filed therein, as well as of other matters, are indulged in. Indeed, we are invited to follow the example and even "challenged" to do so, and the Court is asked to note if the challenge is accepted. We pass this by with

the remark that we are arguing this case on the record which is before the Court, and shall not so far forget a counsel's duty as to depart from the canons of proper practice.

Answering the brief on its merits, there appear to be four defenses relied on:

1. *Prior public use by Grier at Pasadena.*
2. *Surreptitious Patenting by Dunkley.*
3. *Prior public use at Fresno by the California Fruit Canners Association.*
4. *Unclean hands and acts of such iniquitous character as to disentitle plaintiff to any relief.*

These matters we proceed to examine *seriatim*.

THE GRIER PRIOR USE.

STATED IN A NUTSHELL THE DEFENDANTS' CONTENTION IN RESPECT OF THIS DEFENSE IS THAT THEY PROVED BEYOND A REASONABLE DOUBT USE OF THE INVENTION BY GRIER AS OF A DATE PRIOR TO THE DUNKLEY APPLICATION; THAT THEREBY THE BURDEN OF PROOF WAS SHIFTED TO THE PLAINTIFF TO PROVE BEYOND A REASONABLE DOUBT THAT DUNKLEY'S INVENTION ANTEDATED SUCH USE BY GRIER; BUT THAT PLAINTIFF HAS FAILED IN MAINTAINING THAT BURDEN OF PROOF, AND, CONSEQUENTLY, THE GRIER USE OPERATES AS A COMPLETE ANTICIPATION.

This involves three questions, two of fact and one of law, viz.:

1. *The question of fact, was the Grier use proved beyond a reasonable doubt?*
2. *The question of law, was it incumbent upon plaintiff to prove the date of Dunkley's invention prior to the Grier use beyond a reasonable doubt, assuming that the Grier use had been proved beyond a reasonable doubt?*
3. *The question of fact, did the plaintiff successfully maintain the burden of proof required of it, assuming that the burden was as asserted by defendants?*

If the first question be answered in the negative, then the other two questions become useless and need not be considered, because in such event the patent becomes immune from attack by the Grier use by reason of failure of proof of such use.

We challenge the sufficiency of defendant's proof of the Grier use as of the date asserted for it. The date claimed by defendants in that regard appears to be July, 1903. It is true that some evidence was given as to *conception* by Grier in 1902, and also of his *beginning to build* the apparatus in April, 1903; but these matters are wholly irrelevant in considering this particular defense of prior use.

The specific defense under consideration is actual prior use by Grier, and of course there could be no such use until a machine or device was completed and actually put into use. Under the statute it is the actual *use* which invalidates, not the *conception* or *preparation* for use. Those matters might possibly be relevant in some other defense, but they are not relevant in the defense we are now considering.

The crucial question, therefore, is, at what particular date, if any, have the defendants proved the Grier use beyond a reasonable doubt?

Their theory is that they have proved such prior use as of July, 1903. We do not deny that at some time or other Grier used the machine which he says is an anticipation, but we do deny that there is sufficient proof to show when that machine was first

put into use. The story put forward is that some time in July, 1903, Grier completed two machines, one for his own use at the Pasadena Canning Co., and the other for the Eastside Canning Co. at Los Angeles. The Pasadena machine has been dismembered and broken up and there is no physical, concrete evidence left concerning it. The alleged Eastside Canning Co. machine has been produced in Court. There appears to be no dispute regarding its construction, and the crucial question is, when was it first put into use?

Grier himself is the principal witness. He testified (R. 304) that in 1902 he formed a partnership with Mr. Taylor and leased the Pasadena Packing Company plant in Pasadena and there installed a peach peeling machine in 1902, which is not claimed to be an anticipation, although it made use of lye dipping.

(NOTE: This testimony was based on his recollection. The lease of the Pasadena Packing Company was not produced, nor any record evidence relative to the matter).

He then states (R. 305) that "in the fore part of April" of 1903 he employed W. H. Finley, a carpenter, to build him "some tanks," which were to be embodied in the peach peeling machine, which he says he had theretofore conceived, and that these tanks were merely the wooden tubs used with the device; that he built two machines at the same time and "got

them ready for the 1903 peach season"; that the lye tanks used in connection therewith were called grasshoppers, and were purchased from Berger Carter Co. in San Francisco "along in April, 1903."

(NOTE: No record evidence of this purchase was offered, nor was anyone called as a witness from the Berger Carter Company to substantiate the statement, but said statement stands on the recollection of Grier).

It appears that these two grasshoppers were standard machines of the type which had been used many years before for scalding tomatoes. Grier says that they were delivered to his plant at Pasadena (R. 307), though he does not say when; that they did not have heating coils when delivered, and that he put heating coils into them.

Then the following testimony was given by him on page 311:

"Q. When were these two machines in 1903 first assembled and ready for testing in their two respective places, one in Los Angeles and one at Pasadena?

"A. About the latter part of July.

"Q. What was the first test that was made?

"A. I would say about the 28th or 29th of July."

In regard to these tests he says they demonstrated that the grasshoppers were leaky and would not hold water, and he employed two machinists from the Baker Iron Works to chip and caulk them (R. 311).

Continuing his testimony on page 312, he says that the water pressure at the East Side Cannery was not sufficient for the production of operative sprays for the machine and it was necessary to install a pump in connection therewith to obtain additional pressure, which pump was obtained from the Baker Iron Works of Los Angeles, and was delivered, according to his testimony, "early in August, I think the 3rd" (R. 312).

It is quite evident from the foregoing that the use of the East Side Canning Company's machine was after the installation of the pump, and the evidence which the witness gave as to the date when that pump was installed was to the effect that he *thinks* it was the 3rd of August.

Witness was then asked if he could tell by reference to his books when his own machine at Pasadena was first used in 1903, and in answer to that question he says (R. 319):

"A. I could come within a few days of it, yes.

* * *

"Q. Do you remember the date?

"A. Not right off the bat, no.

"Q. How close to it can you give it?

"A. I should judge it was the latter part of July.

"THE COURT: He has said that before:

"MR. MILLER: He said July 29th.

"A. About that date."

Continuing he said that in the next year, 1904, he found it necessary to put a pump in his own machine in order to increase the water pressure for production of the sprays (R. 328).

On cross-examination he stated that the use of his machine at the Pasadena Cannery in 1903 was open and public and no steps were taken to exclude it from the view of the public, although in the following year of 1904 he built a partition around it so as to exclude it from view (R. 336).

(NOTE: This is contrary to the testimony of the witness Finley, the superintendent of the factory, who says that a seven foot partition was placed around the machine in 1903 to exclude it from view, and he was instructed to do that, Grier saying, "This is not a public machine" (R. 251).

On page 339 the witness admits that he never applied for a patent on this machine, although he had applied for and obtained patents on other machines connected with the canning art, one for a curved paring knife in 1900, and the other for a peach pitting machine, in 1898. And very recently he secured a patent on a peach *washing* machine, which he substituted for the alleged anticipating machine after receiving the infringement notice from Dunkley. (This patent appears at page 898 et seq.) In other words, when notified that his machine was an infringement of the Dunkley patent, he discontinued the use of the

same, dismantled it entirely, and substituted in its place a new machine which he devised, invented, and patented himself, and which he claims is not a spraying machine, but is nothing more than a *washing* machine (R. 342-3).

From the foregoing review it will be seen that Mr. Grier relies upon his memory for fixing the use of the machine and the date of such use, save and except for two vague and indefinite entries in his books of the sale of some kind of machinery to the East Side Canning Co., hereafter to be noticed, and his recollection is that the two peeling machines were tested "about July 28th or 29th," and that *he thinks* on August 3rd the East Side Canning Co.'s machine was finally completed by the addition of a pump for increasing the water pressure and thereby producing the necessary spray effect. Consequently, it can not be claimed by defendants that the alleged prior use actually began until after August 3rd, 1903, and even that date is dependent upon memory. We assert, therefore, that Grier's testimony fails to prove beyond a reasonable doubt any particular date at which his alleged prior use began. All that he pretends to testify to is that it began somewhere along the latter part of July or the beginning of August, and was continued during the peach season of 1903. It seems to us that such evidence is insufficient and does not measure up to the standard required by the law for showing anticipation by prior use. If such contention is

well founded, then all of Grier's evidence with reference to use in 1903 must be disregarded.

W. H. FINLEY was called by defendants for the purpose of corroborating Grier. He testified that he was a carpenter and that he went to work for Mr. Grier at his Pasadena cannery in April, 1903, to build an addition to his plant, a boiler house (R. 236); that after fixing up the boiler house he built two sets of redwood tanks for peach peeling machines, one for the Pasadena Cannery and one for the East Side Cannery (R. 237); that he got them finished before the peach season opened and *he thinks* it was about the middle of July (R. 239); that the machine was put in operation in the Pasadena cannery "in 1903."

When asked as to the date of completion of the peach peeling apparatus, he answered (R. 241):

"I could not state the date, but it was along in connection with the work I was doing on the tanks and the peeling apparatus.

"Q. I mean, when was it completely assembled?

"A. Well, as I said a little while ago I think about the middle of July.

"Q. 1903?

"A. Yes, 1903. Of course there might have been some minor alterations made, but it was ready then for experimental work, I am satisfied, as early as that."

(NOTE: This testimony does not tally with that of Grier, who says the machines were first tested about

July 28th or 29th; nor with that of Herman, who fixes the date as July 10.—R. 358.)

Continuing, the witness says that he operated the Pasadena machine during the season of 1903 and during the season of 1904, and also in the seasons of 1906-7 and 8, being absent in 1905 (R. 245). That the machine was used during the season of 1903 "for washing peaches."

(NOTE: The witness continually uses the term "washing," instead of "peeling," during his entire testimony, always referring to the machine as a machine for *washing* peaches, or as a *washing* machine.)

He says that in 1903 he had instructions from Grier not to allow people to examine the machine and he was prohibited from giving any information on the subject, he being the man in charge of the machine, and he constructed a seven foot partition around the machine so as to exclude it from view, Grier saying to him, "This is not a public machine" (R. 250-1).

(NOTE: This is contrary to the testimony of Mr. Grier, who says that the machine was in open public use and was not enclosed by any partition in 1903.)

Continuing his testimony witness says that he built the two machines from verbal descriptions given him by Mr. Grier, and that he had no drawings (R. 253). When asked the date of installation of the machine

in the East Side Canning Company he answered, "I cannot recall the date, but it evidently was in July, 1903" (R. 256).

When he was asked how long it was after he installed the machine at Pasadena and made the preliminary tests before the machine was running at full capacity, he answered at page 271, as follows:

"A. I don't know; it was a short while because when the peaches begin to get ripe they ripen up pretty rapidly and you can't have much delay.

"Q. What is your best recollection—how long was it after you tested the machine before you had it running full capacity?

"A. Well, I could not say on that; it might have been a week; it might have been two weeks.

* * *

"Q. Now, then, the question I asked you: how long was it before this general crop that you made your tests to know that the machine was right?

"A. I don't know; it was not a very long time.

"Q. You do not remember about that?

"A. I do not remember about that; I did not pay any attention to that; that did not concern me, and I did not pay any attention to it.

"Q. If the crop came along about the middle of August it might have been the first of August that you made this test; is that right?

"A. It might have been.

"Q. Your recollection is in no way clear that it was during the month of July? It might have been early in August; that is right?

"A. It might have been early in August; it might have been in the middle of July or later; I am not clear on that because I paid no attention to that at all" (R. 273).

It will be seen from the foregoing that the testimony of Finley does not begin to measure up to the standard required by the law for proving anticipation. It is based entirely on his memory, thirteen years after the event. And in one respect he squarely contradicts Mr. Grier, where he testifies that he was ordered to keep the machine secret and that a seven foot fence was built around the machine to exclude it from public view, whereas Grier testified that there was nothing of the kind and that the machine was at all times in open, public view. It is more likely that the testimony of Finley on this subject is correct, for not only is he a disinterested witness, but it would be a natural proceeding for Grier to have taken. He was a patent man accustomed to designing new machines and securing patents, and it is quite likely that he would have desired to preserve this machine in secrecy. Under these circumstances no credence can be given to his testimony regarding the absence of the seven foot fence, and if he has testified falsely in respect of that matter, he is to be distrusted in respect of other matters.

Finley's testimony is also at variance with that of Grier in reference to the date of completion, Finley putting it at the middle of July and Grier on the 28th or 29th of July.

WITNESS C. L. KENNEDY gave a short deposition, appearing between pages 349 and 353. He testified that in 1903 he was working for the San Jacinto Packing Company in Riverside County, but during that year he visited Mr. Grier's plant at Pasadena, and in that behalf gave the following testimony at page 352:

"Q. In 1903, were you at any time in Mr. Grier's plant at Pasadena?

"A. Yes.

"Q. Did you know anything about whether or not he had any machine there?

"A. He had; he had this machine of his laid up, that we have been talking about.

"Q. Can you describe the machine as you saw it down there in 1903?

"A. As near as I can remember it was the same identical machine that we had at Orange County Preserving Co. in 1904.

"Q. You mean one just like it?

"A. Yes, one just like it."

This testimony is scarcely worthy of serious consideration. It is merely the recollection of the witness thirteen years afterwards of what he saw in Grier's cannery on a casual visit thereto, and even at that it does not appear that the machine was in use, for he says that it was "laid up." Nor does he fix any specific date, merely saying it was "in 1903." Such testimony is of no value in proving a matter of this kind.

W. F. HERMAN (R. 354-360) testified that he worked for Grier in 1903—"on or about the 15th of June"; that he there met W. H. Finley who was "building some tanks"; that he (witness) assisted in the installation of the machine; that the grasshopper "leaked very badly" and Mr. Grier had some mechanics come and fix it up, and after that it was used for peach peeling, but witness did not have anything to do with its operation, not being employed on the machine. If Grier's statement that the tests were not made until July 28th or 29th is true, then it must have been after that date that the mechanics came and stopped up the leaks.

On cross-examination he testified that the earliest day he remembered of seeing this peach peeling machine operate at the Pasadena cannery was "in July, 1903," and when he was asked what made him think it was in July, he replied as follows (R. 358):

"Because it was used on the free stone peaches; they get ripe about the 10th of July and it was used at the start" (R. 358).

This is contrary to the testimony of both Grier and Finley, the former fixing the date as July 28th or 29th, and the latter as the middle of July. Here we find a material conflict between this witness and Grier and Finley, and that too on the crucial point of the case, viz: the time when the use of this machine began.

But to make matters still worse, this witness was asked, at page 358, if he was sure that the machine was tested before July 29th, and he answered, "No, I can not swear to that." What explanation is to be given of this answer? He had already testified that the use of the machine had begun on early free stone peaches about July 10th, and then immediately after that he says he could not swear that the machine was tested before July 29th. Clearly this man's testimony is not worthy of much consideration.

MRS. ALMA GRIER, wife of the defendant George Grier, gave testimony to the effect that she worked in the Pasadena Cannery during the peach season of 1903 (R. 366); and that this peach peeling machine "was used in 1903" (R. 367); that she never saw the East Side Canning Company's machine in actual use (R. 368).

The sum and substance of this lady's testimony is merely to the effect that according to her recollection her husband's peach peeling machine was used during the peach season of 1903. She does not attempt to fix any date at which this use began. Hence her testimony is of no value as fixing any such date.

G. C. WATERHOUSE testified that he was a school teacher; that he worked for the Pasadena Cannery Company in 1902, and worked there for three

years during his summer vacations. He was then asked the following question (R. 373):

"Q. During any of those summers, or during those seasons, did you have anything to do with the peeling of peaches?"

and he answered that he was employed in carrying peaches from the end of the peeling machine to the packing table, and then he undertook to describe the peeling machine, which he did in a vague and general manner. He was not asked on direct examination when he first saw this machine, but on cross-examination he gave the following testimony on the subject (R. 376):

"Q. When did you first see it?

"A. I don't know just when—the second year I was there is the first time I saw the machine or got acquainted with it.

"Q. What month did you go there in that second year, 1903?

"A. I could not tell you exactly the month; it was around the close of the school year; I was in school at the time.

"THE COURT: Q. What time did school close?

"A. I believe in June. I went to work there permanently then, that is, for the summer season.

"MR. CHAPPELL: You think you went to work there in June and saw the machine in operation there in June?

"A. I could not say; it was during that season that I worked on the machine, and took the fruit

away; I don't remember just the time that we started to peeling the peaches."

Clearly this testimony does not measure up to the required standard.

EDWARD A. TAYLOR testified that he was engaged in the canning business and was in partnership with Mr. Grier from 1902 until the fall of 1906 at Pasadena (R. 379): that during the year 1903 he used the Grier machine in controversy for peeling peaches at the East Side Canning Company; that he first tried the machine two or three days, but found the water pressure too low, and thereupon he bought a pump from the Baker Iron Works in August, 1903, and installed the same in the machine for the purpose of producing the necessary sprays (R. 380-1); that during 1903 he was at the Pasadena Canning Co. during the peach peeling season and they were peeling peaches there with the same kind of a machine, and that said machine was identical with his machine used at the East Side Cannery (R. 382).

The substance of this testimony is that at some time during the peach peeling season of 1903, these two Grier machines were used. No definite date is given.

MARY E. MAYES testified that she worked in the Grier cannery in Pasadena from 1902 to 1916; that "in 1903" they used Grier's new machine with a grasshopper (R. 387).

Clearly there is nothing definite in this testimony.

F. F. STETSON testified that he was the proprietor of a small cannery in Southern California, and then gave the following testimony at page 389:

"Q. Were you ever in his (Taylor's) East Side Canning plant on North Ave., Los Angeles?

"A. Yes.

"Q. Do you know how he peeled peaches in that plant?

"A. Yes. He peeled them with lye using the machine known as the Grier machine, made in Pasadena.

"Q. When did he first use that machine?

"A. In 1903, I believe."

Like all the other testimony referred to, this merely goes to show that the Grier machine was used "in 1903"; but it is not as definite as the testimony of the other witnesses, for this man merely says that he *believes* it was in 1903. Clearly his *belief* is not competent proof of the fact of use.

FRANK H. SANBORN testifies that during the years 1901, 2, 3 and 4, he was in Mr. Taylor's employ at the cannery at East Side, and that in 1901-2 and 3 he used a lye process for peeling peaches (R. 392); that "in 1903" a change was made in that process and that "in 1903 they put in a machine that scalded the peaches and it went from that into a line of tanks or a line of tanks or carriers they were washed." Also after "leaving the scalding tank they went on to a washing arrangement with sprays, coming from the

scalder it went on to a platform, a cradle arrangement," and that it was the style of arrangement similar to the one shown in Court (R. 393).

This evidence is insufficient to establish any definite date. He merely says the use was "in 1903," and he does not give any accurate description of the machine.

LUSBY, a bookkeeper, also testified that he saw the Grier machine, styled "the line machine," operating on peaches "during the year 1903" (R. 294).

So far as we now recall, the foregoing constitutes all the evidence introduced by defendant for the purpose of showing a prior use of the Grier machine at Pasadena and East Side canneries during the year 1903. We submit that the evidence is insufficient for proving the date of such use beyond a reasonable doubt. At most it merely shows that the machines were used sometime during the peach season of 1903. It does not conclusively show when that use began, which is the crucial question in this connection. All presumptions in a matter of this kind must be taken against the party alleging the prior use, because the use, in order to avail, must be proved beyond a reasonable doubt.

We do not lose sight of the fact that some book accounts were offered in evidence by the defendants, presumably for the purpose of fixing dates; but they are insufficient. They are copied at pages 296-7 of the

record, the material ones appearing on page 297. The first item is under date of May 29, 1903, and consists of a charge against the East Side Canning Co., for what is designated there as "Tool & Fix, \$278.00." This entry fails to identify anything with sufficient clearness to enable us to know what it covers. It would appear to refer to tools and fixtures, but what those tools and fixtures are is not apparent from the entry itself. Certainly there is nothing in the entry to show on its face that it refers to a peach peeling machine. Grier says it refers to grasshoppers; but that is merely his recollection, and furthermore such grasshoppers had been used for scalding tomatoes for many years. Consequently, if this term "tool & fix" referred to a grasshopper, the probability that it was a tomato scalding machine is not excluded. Also note the date of the entry—May 29; but it is not claimed by Grier that the peach peeling machine was finished and tested until July 28th or 29th. Query,—May not the entry refer to some other machine, which was purchased a month before the peeling machine was finished, for instance—a tomato scalding machine? Such alternative is not excluded by the evidence.

Another entry is one taken from page 54 of the journal, dated July 30, 1903, and consists of a charge against the East Side Canning Co. for "4-Convey vats—main line—Putting in vats and placing in steam coil," and then underneath this ambiguous entry appear the words "Tools & Fix 225.00, labor 50.00."

Like the items first referred to, this one is also indefinite in terms and does not show on its face that it refers to a peach peeling machine. Grier says it refers to the four vats of the lye machine, but that is merely his recollection. Why those four wooden vats should be styled tools and fixtures is not apparent.

Another item in the journal, at page 55, is a charge under date of July 31, 1903, against the East Side Canning Co., for "soda, etc., per Inv. 19.69."

The last item is September 18, 1903, being a charge to East Side Canning Co. for "soda per Inv. 39.38." The only relevancy of these last two items would appear to be that the Pasadena Canning Co. sold to the East Side Canning Co. some soda; but as it appears from the evidence that the lye dipping or soda process by means of wire baskets had been used in these canneries since 1902, it may be that this soda was used for that purpose. There is nothing on the face of the entry to show that this soda was used in the Grier peach peeling machine in 1903.

We submit that the defendant's evidence is not sufficient under the rule to fix any definite date when the Grier use began. If so, then it is unavailing for the purpose of anticipation. If it be argued that it at least fixes a use in the peach season of 1903, then under the rule of presumptions applicable to such cases the use could not be predicated as of any date prior to the end of the season. But when did the

peach season end? The evidence does not fix that date, and one of the witnesses of defendant's states that the peach season for 1903 was late.

BURDEN OF PROOF.

BUT ASSUMING FOR THE PURPOSES OF THE ARGUMENT THAT THE GRIER USE WAS PROVED BEYOND A REASONABLE DOUBT, WHAT WAS THE MEASURE OF PROOF REQUIRED OF THE PLAINTIFF IN CARRYING THE DATE OF THE DUNKLEY INVENTION BACK OF SUCH GRIER USE?

In the defendant's brief it is asserted that such burden of proof "is precisely the same burden that was in the first instance upon the defendant to prove such Grier invention," that is to say, *proof beyond a reasonable doubt*. We challenge this contention and assert that the quantum of proof required of plaintiff in such contingency was merely a *preponderance of evidence which convinces the court*.

The rule is laid down in *Walker on Patents*, at the end of Section 76, in the following language:

"Where an anticipating fact prior to the date of a patent is proved beyond reasonable doubt, the burden is shifted to the plaintiff to prove, by convincing preponderance of evidence, that his invention was made still earlier than that fact occurred; and if the plaintiff does not introduce enough evidence to strongly outweigh whatever evidence is introduced to the contrary, the patent must be held to be void for want of novelty."

In support of this rule the author cites *Clark Thread Co. vs. Willimantic Linen Co.*, 140 U. S., 492, and many other cases.

In opposition to this defendants rely upon three cases, viz:

Thayer vs. Hart, 20 Fed. Rep., 693;

Dey Time Register Co. vs. Bundy, 178 Fed. Rep., 818;

Wheaton vs. Kendall, 85 Fed. Rep., 672.

Thayer vs. Hart was a decision by a *nisi prius* court in the Southern District of New York, and did not relate to a contest between plaintiff's patent and a prior use, but related to a contest between plaintiff's patent and defendant's patent. In other words, both parties owned patents, and the Court says:

"The principal controversy relates, therefore, to the question of priority of invention."

In such case one patent is entitled to the same presumption as the other. They both stand on the same footing. The defendant succeeded in proving beyond a reasonable doubt that the invention of his patent was made eleven months prior to the filing of complainant's application. In fact the Court says that this was "conceded on the argument." In this state of the case the Court held that it was incumbent upon plaintiff to show the date of the invention of his patent anterior to the defendant's date by the same character

of evidence as that produced by the defendant, to-wit, proof beyond a reasonable doubt. This was apparently based on the theory that the defendant's patent was entitled to the same presumptions as plaintiff's patent, and the measure of proof in each instance was the same. But where the contest is between the plaintiff's patent and a prior use which never eventuated in a patent, then the rule is different. In such case plaintiff is not required to prove the date of his invention beyond a reasonable doubt, but only by a preponderance of evidence which convinces the Court.

This distinction seems to be recognized by the Court of Appeals for the First Circuit in the case of *Westinghouse v. Stanley*, 133 Fed., 174, where the two rules are discussed, and the milder one adopted, following the decision of the Supreme Court in the case of *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S., 492.

This Court also seems to make the same distinction in the case of *Wilson & Willard Mfg. Co. v. Bole*, 227 Fed., 609-10, where the controversy was between the plaintiff's patent and the defendant's application for a patent, which was pending in the Patent Office before the issuance of plaintiff's patent. In that case this Court held that the "reasonable doubt" rule did not apply to either patent, on the principle that where the contest is between two rival patents, each of which is entitled to the same presumption, the reason for

the rule applicable in a case of an unpatented prior use ceases, and therefore the rule ceases with it.

The second case cited by defendant, that of *Dey v. Bundy*, 178 Fed., 812, was by the Court of Appeals of the Second Circuit, the same circuit in which *Thayer v. Hart* was decided, and the conclusion reached was based entirely upon *Thayer v. Hart* as an authority. It was not a case between two rival patents, but the Court analyzed the plaintiff's proofs regarding priority of invention and criticised them sharply as being unsatisfactory and not convincing. No records were produced by plaintiff to sustain his contention, and his proofs consisted merely of the recollection of witnesses. It is further to be noted that it was one of the plaintiff's own witnesses who furnished the proof of the prior use relied on by the defendant, the same having been brought out on cross-examination. That proof, says the Court, "was very positive and specific and supported by record entries in the books of the manufacturers." And it is further to be noticed that the plaintiff conceded the date of the prior use as claimed by the defendant. It is evident from this that it would require strong proof on the part of the plaintiff to antedate that prior use, and it would appear that it was by reason of such consideration that the Court held plaintiff's proofs in that regard insufficient.

But if it be held that this *Dey Time Register Co.* case establishes the doctrine that in a case of contest

between plaintiff's patent and an unpatented prior use plaintiff must antedate the prior use by evidence beyond a reasonable doubt, we submit that such holding is contrary to the text books, the decisions of the Supreme Court, the Court of Appeals of other Circuits, and the decisions of this Court. Hence it should not be followed.

The third case cited by defendant is *Wheaton v. Kendall*, 85 Fed., 672; but it has no bearing on the issue here involved. That was a case brought under Section 4915 of the Revised Statutes to determine the question of priority of invention between two conflicting applications in the Patent Office after a decision therein against one of the parties and the issuance of a patent to his rival. In such a case one man is entitled to no advantage over the other in respect of presumption, and the same rule of evidence is applicable to each of them. The issue in such case is, which of the two was the first and original inventor of the invention covered by the interference? There is no such question in the case at bar. The only question here is, whether Dunkley made his invention prior to the date of the unpatented use by Grier. There is no contest as to priority of invention between Dunkley and Grier, nor could there well be, because Grier never applied for a patent at all on the device. We think these considerations differentiate the Wheaton case from the one at bar, and we reiterate our position as follows:

Whatever may be the quantum of proof required of a plaintiff in carrying the date of his invention back of an anticipating patent issued to another in a case where the contest is between plaintiff's patent and the other patent, the law seems to be settled that in case of a contest between plaintiff's patent and an unpatented prior use defendant on the recollection of witnesses, the quantum of proof required of plaintiff in carrying the date of his invention back of such use is merely that of a preponderance of evidence which satisfies the Court, and he is not subject to the stringent rule of "no reasonable doubt."

THE BEEKHUIS PATENT AND INTERFERENCE.

It appears that while Dunkley's application was pending in the Patent Office a patent was issued to Beekhuis for the same invention, whereupon an interference was declared, which ultimately resulted in favor of Dunkley.

The defendants contend that the introduction in evidence of this Beekhuis patent, which was dated September 3, 1907, cast upon plaintiff the burden of proof of carrying the Dunkley invention back of that patent. Ordinarily this would be true. But it is not true in this case, because the defendants introduced in evidence at the same time a certified copy of the file wrapper contents of the Dunkley patent, from which it appears that an interference was declared

between Dunkley's application and the Beekhuis patent, and that said interference was determined in favor of Dunkley, thereby establishing of record the fact that Dunkley's invention antedated that of Beekhuis. Thus we see that defendants themselves by their own evidence destroyed all possible effect that might presumptively arise from the issuance of the Beekhuis patent. Had they been content to introduce the Beekhuis patent without accompanying it with the Dunkley file wrapper contents, we would have been confronted with a different situation. But by their own acts they have nullified any presumptive effect arising from the Beekhuis patent, and that patent cuts no figure in the case except as strengthening Dunkley's contention.

It is also averred by our adversaries that the decision of the Court of Appeals for the District of Columbia in favor of Dunkley in the interference "in no way affects the situation in this case," it being asserted that only one point was there considered, to-wit, "whether or not Dunkley was entitled to make the claims calling for peeling jets, in view of the fact that in his application, as filed on November 29, 1904, and as prosecuted until after the time he saw the Beekhuis patent, Dunkley had not used the term 'peeling jet' or 'peeling spray' or any equivalent term" (Defendant's brief, p. 25). It is iterated and reiterated again and again by defendants in their brief that such issue was the only one involved in the inter-

ference, and that the question of priority of invention by Dunkley was not an issue, but was undisputed. But reiteration of an erroneous statement cannot inject truth into it, however vociferous and violent the reiteration may be.

This statement is wholly erroneous. *Priority of invention was in dispute in the interference.* Testimony was taken thereon, and indeed that is the only point on which testimony was taken. It is quite true that *one* issue in that case was the right of Dunkley to make claims for peeling jets, which issue was decided in favor of Dunkley. After that question of law was decided, then the issue of fact as to priority of invention arose, and after testimony taken was decided in favor of Dunkley.

In the decision of the Commissioner of Patents, copied at the end of Defendants' brief, after defining the issues, it is said:

"Both parties have taken testimony. * * *

"The dates alleged in the preliminary statements of the respective parties are as follows:

		Dunkley	Beekhuis
Conception	August 1902,	July	1903
Disclosure	Sept. 1902	July	1903
Reduction to practice	July 1903	February	1904

"The testimony in behalf of Beekhuis shows that about July, 1903, he performed certain experiments in peeling fruit by the use of jets of water.

Beekhuis testifies (Q. 10) that he used a hose to direct a jet of water upon peaches which had been treated with a skin-disintegrating solution and that he discovered that the jets would perform the operation of peeling the fruit. His testimony in regard to these experiments is corroborated by that of the witnesses Fontana and DeRegt. These experiments apparently proved to Beekhuis that the idea of using jets of water for peeling fruit was a feasible one. But they do not show, however, that at this time Beekhuis had a full conception of any mechanism by which this idea was to be carried into practical operation. In fact, Beekhuis practically admits (Q. 10, page 12) that he had no conception of any such mechanism when he states that the question of how to manipulate the fruit and use the water jets would have to be worked out. The testimony of the other witnesses is also deemed insufficient to show that Beekhuis had a conception of the invention in July, 1903, or at any time prior to the building of his first machine, which was in the early part of 1904. The testimony shows that this machine was completed about February 1, 1904, and was first successfully operated in the following summer. It is also clearly shown that said machine included the invention in issue, and its successful operation about June, 1904, entitled Beekhuis to that date for reduction to practice of his invention.

"Dunkley claims to have conceived the invention in August, 1902, and to have reduced the same to practice by the construction of a peach-peeling machine in July, 1903. He also claims to have built a second machine of larger capacity in September of that year. It is unnecessary to consider the evidence in regards to Dunkley's conception of the invention. If the machines

above referred to contained the invention in issue and were actually built and successfully operated at the time alleged, it is clear that Dunkley is entitled to a reduction to practice of the invention prior to any date of conception satisfactorily established by Beekhuis.

"The evidence is deemed sufficient to show that two peach-peeling machines were built by Dunkley at the time alleged. * * * This evidence satisfactorily establishes that Dunkley built and successfully operated fruit peeling machines at least as early as the fall of 1903, and he is therefore entitled to that date for reduction to practice of whatever invention was included in these machines."

It will be seen from the foregoing that priority of invention was an issue of fact involved in the interference and the same was decided in favor of Dunkley. The Commissioner of Patents then went on in his opinion to hold that Dunkley was not entitled to make the claims for peeling jets because of an insufficient disclosure thereof in his original application.

The case then went to the Court of Appeals for the District of Columbia, which court affirmed the ruling as to the issue of priority but reversed it as to the right to make the claims to peeling jets and decided that Dunkley was entitled to make such claims, and that there was sufficient basis for them in his original disclosure. In deciding the case, the Court of Appeals said:

"All the tribunals of the Office found that Dunkley was the first to conceive and reduce to practice, provided he was entitled to make the claims of the issue, and this decision was undoubtedly right."

And in winding up its decision, the Court of Appeals said in reference to Dunkley:

"His specifications and construction afforded sufficient foundation for the claims; and as he was the first to conceive the idea and reduce it to successful practice, he is entitled to the award of priority. The decision will, therefore, be reversed; and this decision will be certified to the Commissioner of Patents."

It will be seen from the foregoing that the issue of priority of invention was involved in the interference, and that "all the tribunals of the Patent Office" decided that issue in Dunkley's favor. This demonstrates the error of our adversaries when they say that such an issue was not involved in the interference. The sum and substance of the interference matter is that Beekhuis was defeated on the question of fact as to priority of invention, and then resorted to the technical expedient of contending that, although Dunkley was the prior inventor of the peeling jets, he was disentitled to make the claims because of an insufficient disclosure thereof in his original specification. This was the last resort of a badly defeated litigant, which ultimately went the way of the other issue.

PLAINTIFF'S PROOFS OF DATE OF INVENTION.

BUT WHETHER VIEWED UNDER THE "REASONABLE DOUBT" RULE OR THE "PREPONDERANCE OF EVIDENCE" RULE, THE PROOFS SUBMITTED BY PLAINTIFF IN REBUTTAL ARE AMPLY SUFFICIENT TO ESTABLISH THE DATE OF DUNKLEY'S INVENTION PRIOR TO THE GRIER USE.

Plaintiff's evidence in that behalf consisted of the testimony of S. J. Dunkley, Melville E. Dunkley, Harvey C. Schau, Exhibit 10 (the original frame of the first experimental machine), certain written exhibits, and the decision of the Court of Appeals of the District of Columbia in the Interference case of *Dunkley v. Beekhuis*, together with the inferences logically deducible from the facts and circumstances of the case and the experience, career and standing of the patentee Dunkley. In addition to this, the case was tried in open court and the Judge thereof was enabled to determine for himself the credibility of the witnesses.

Mr. Dunkley is a prolific inventor in the fruit canning art, having taken out from time to time during his career ten or more patents prior to the one in controversy. They are catalogued at pages 476-7. He owned two canning establishments, one at South Haven and the other at Kalamazoo in the State of Michigan, where enormous quantities of

fruit were processed, employing from two to three hundred operatives (R. 481) and using a million cans per annum (R. 478). It was his business to keep abreast of the times in the matter of new inventions and labor saving improvements. He details the circumstances under which he conceived the invention, the time being fixed in August, 1902, when he explained it to his son (R. 479). During the summer of that season he built the model machine, of which the frame is represented by plaintiff's Exhibit No. 10 (R. 479-80), the same having been preserved and brought into court at the trial. This is now before this Court. He tested out the principle of the invention with that machine in 1902 (R. 479), but without the use of a connected lye tank (R. 451). That was at the end of the peach season of 1902. In the following spring he ordered from the Clark Engine & Boiler Co. a lye tank to go with the machine, and in July, 1903, this lye tank was coupled up with the machine, and the same was used during the peach season of 1903, beginning about July 15th, upon the early Georgia peaches brought from the South, and continuing until the end of August, or thereabouts (R. 415-18, 435, 438-40, 463-6). This first machine was of a rough character and was soon superseded by a new machine of larger capacity built during the summer of 1903. This larger machine was used some in the peach season of 1903 and largely in 1904, with great success, and thereafter, on

November 29, 1904, Dunkley filed his application for a patent.

This application met with a stormy passage through the Patent Office. While it was pending and before issuance it was discovered that the Patent Office had issued to one Beekhuis a patent for the same invention, the Beekhuis patent being numbered 864,944, dated September 3, 1907, application filed May 25, 1904. After many hearings in the various Patent Office tribunals, some of which were in favor of Dunkley, and others in favor of Beekhuis, the controversy finally went to the Court of Appeals of the District of Columbia and was decided by that Court on January 6, 1913, in favor of Dunkley, in which decision the Court of Appeals says:

"All the tribunals of the Office found that Dunkley was the first to conceive and reduce to practice, provided he was entitled to make the claims in the issue, and this decision was undoubtedly right."

In closing its decision, the Court said in reference to Dunkley:

"And as he was the first to conceive the idea and reduce it to successful practice, he is entitled to the award of priority."

During the interim the canners of California had put the invention into extensive use, so that when Dunkley finally emerged from the Patent Office in

July, 1914, he found himself confronted with a multitude of infringers scattered throughout the State of California. Some of these infringers utilized the specific construction claimed to have been used by Grier in 1903. Others used a different form of construction consisting of a revolving cylinder with spray pipes extending longitudinally through the center. These two forms of construction are involved in the present eight cases now before the Court, some of the defendants using one construction and some using the other.

Dunkley's fight has been a long and tedious one, covering a period of fourteen years up to date, and there appears to remain a long fight still awaiting him in his efforts to secure for himself that remuneration which the law awards him for the highly useful invention which he has made.

The witnesses called by plaintiff to prove the above facts were S. J. Dunkley (R. 475 et seq.), Melville E. Dunkley (R. 413 et seq.), and Harvey C. Schau (R. 513 et seq.). S. J. Dunkley is the patentee, M. E. Dunkley is his son, and Schau was at the times in question an employee of the Dunkleys, but is not now connected with them in any capacity.

The chief criticism which our adversaries urge against the Dunkley proofs is the assertion that at the trial of the case the two Dunkleys testified differently from what they testified in the Beekhuis interference in the Patent Office. In that behalf it is

contended that in the Interference case they testified that the first experimental machine (Plaintiff's Exhibit 10) was made in July, 1903, whereas at the trial of this case they testified that it was made in 1902 and put to use in July, 1903.

If that contention were true, it would not alter the result, because July, 1903, is prior in time to the Grier use. Defendants appear to think that the exigencies of the case developed at the trial required the Dunkleys to change the time of the building of this model from 1903 to 1902 in order to antedate Grier, and they assert that the Dunkleys did so change their testimony for the purpose stated, and that in doing so they deliberately committed perjury. But, as we have already shown, if the model was not built until July, 1903, that would be sufficient to offset the Grier use, and, consequently, there was no need or occasion, much less any intention on the part of the Dunkleys, to change their testimony by carrying back the date of the model one year from the date given in the interference proceedings. It is scarcely to be presumed that a witness would *unnecessarily* commit perjury. When perjury is committed it is generally in pursuance of a dire necessity required by some exigency of the case. There was no such necessity or exigency in this case, because July, 1903, was a sufficient date for plaintiff's purpose. Hence there could have been no motive for perjury. *But there was no change of testimony by*

the Dunkleys in respect of this matter, and the contention put forward by the defendants in that behalf is in our opinion the pure figment of an over-wrought imagination. Judge Van Fleet took no stock in the theory, for he says in his opinion (R. 697) that he was unable to find any essential difference in the testimony given on the two occasions.

But let us examine the facts on which the defendants predicate the alleged change of testimony. The best way to elicit the whole truth would have been to put in evidence the entire record in the Interference proceedings for comparison with the testimony in this case. The plaintiff was not entitled to put that record in evidence, but would have been very glad if it had been put in evidence. Defendants on the other hand were entitled to put it in evidence, but declined to do so. Instead thereof they read to the Dunkleys certain questions and answers and then asked them if they gave that testimony in the interference proceedings, to which they replied in the affirmative.

As regards S. J. Dunkley, he was asked on cross-examination if he did not testify in the Patent Office proceedings regarding his first experimental machine, that

"It was made in the month of July, 1903, and put together at the factory at South Haven, Michigan."

As regards Melville E. Dunkley, he was asked if he had in the Patent Office proceedings identified a certain photograph and testified that

"It is a photograph of the frame and some parts of the original machine built during the summer of 1903, about which I have just testified."

These questions were answered in the affirmative, and upon those answers defendants predicate their charge of change of testimony. As we have already remarked, the entire record was not produced. Hence it does not appear whether those answers were modified or affected by any other evidence in the Patent Office record. Defendants were careful not to put the record in evidence. The Dunkleys stated that in giving those answers they had in view the complete machine, that is to say, with a lye tank added. Since then they have unearthed the Clark letter of April 21, 1903, showing that the lye tank was built in April, 1903, and this letter refreshed their recollection of the transaction so as to enable them to now state that the frame work and spray part of the machine had been built before the lye tank, and in following the matter back they now recollect that the frame work and spray part were built in 1902. Until this Clark letter was unearthed the Dunkleys were not sure in their recollection that the frame work was built in 1902, although they were sure that it was in existence as early as July, 1903; therefore

in the Patent Office proceedings they were justified in fixing the date at least as early as July, 1903. But the Clark letter changed the situation somewhat and proved to them that the lye tank was built in April, 1903, and as the spray part was built and tested without the lye tank, it necessarily was built before April, 1903. In other words, the production of the Clark letter enabled the Dunkleys to remember that the spray part of the machine was built in 1902, and that a complete machine was installed with a lye tank added in July, 1903. Consequently, the present situation presents two alternatives, viz: In giving the interference testimony the Dunkleys either referred to the completed operative machine including a lye tank, or they were honestly mistaken in saying that the frame work was built in July, 1903, if such construction can be placed upon their testimony. Under the first theory there can be no pretense of a change of testimony. Under the second theory it is merely the case of an honest mistake, subsequently corrected by the discovery of record evidence. A witness is always allowed to correct an error inadvertently made, and it would be a very harsh rule to hold that such correction convicts him of perjury. We submit that there was in substance no change of testimony. Judge Van Fleet was of that opinion, and he had a much better opportunity to decide the matter than is afforded by a mere reading of this record.

He carefully considered all these matters and was

convinced that the Dunkleys were telling the truth, and ruled that there was no "essential difference" between the testimony of the Dunkleys given in this suit and that given in the Interference suit. We submit that there was no error in the ruling.

But after all, how will the defendants dispose of the testimony of Harvey C. Schau? He was superintendent of the Dunkley factory and worked for them from February, 1902, to March, 1908 (R. 513). Consequently, he was thoroughly familiar with the cannery and the operations carried on therein. He saw Mr. Dunkley experimenting with the matter in *July, 1902* (R. 514). He was in the South Haven cannery in *November, 1902*, saying that he was "very certain of that date" (R. 514). On that occasion he there saw in the cannery the frame work of this model machine, Exhibit No. 10, and identified the same in court (R. 514-15). He then testified that either the day before or the day after the 4th of July, 1903, he saw the complete machine at Kalamazoo and soon thereafter it was moved to South Haven and operated at the beginning of the peach season in 1903 (R. 515). He had charge of the machine room; consequently, had a good opportunity to see the machinery (R. 516).

Surely there can be no criticism as to this man's testimony. Indeed, none was attempted except the assertion that he was nineteen years old at the time. He is entirely disinterested, not being connected at

this time with the Dunkley interests. If he saw the machine without a lye tank in November, 1902, and saw it with a lye tank added, on July 4, 1903, then the Dunkley narrative is corroborated. When we add to this the Clark letter of April 21, 1903, regarding the lye tank, the proof becomes complete.

We can not leave this subject without voicing our disapproval of the intemperate language used by our adversaries at page 73 of their brief, where they quote a statement made by us at the oral argument below regarding this matter. It is true that we there made the statement that the testimony in the interference case was the same as the testimony in the case at bar. On its face this statement may appear to be too broad, but it was merely a statement made in oral argument by counsel which was not excepted to at the time, and which is not shown to have influenced the Court. It is not unusual in the heat of a verbal debate during a hotly contested case for an attorney to color his statements more vividly than he would in the seclusion of his office when writing a brief, and a charitable view to take would be to attribute his course to excessive zeal. But to attribute it to a deliberate intent to deceive the Court, and to characterize it as being "despicable and contemptible," and used for the purpose of "bolstering up a charge of false swearing made against honest men," so far exceeds the bounds of propriety as to be inexcusable. Much latitude may be accorded to

zeal and enthusiasm, but no justification can be made for a breach of decorum. We resent the charge with indignation, trusting that our long experience before this Court will justify the conclusion that there was no intent on our part to deceive the lower court.

Another criticism made against the Dunkleys is that they produced no written records. But counsel seem to have overlooked the testimony given by M. E. Dunkley at page 445 of the record, to the effect that in 1912 the Dunkley cannery was destroyed by fire and their records were lost.

THE STEWART CAMPBELL EPISODE.

Under the guise and pretense of meeting plaintiff's evidence as to the date of the Dunkley invention, defendants produced as a witness one Stewart L. Campbell, whose deposition appears between pages 523 and 595 of the record. The substance of his testimony is that Dunkley was not the inventor of the device patented, but that he, Campbell, was the sole and original inventor thereof.

Before considering Campbell's testimony we desire to call the Court's attention to the procedure under which it was produced. If Campbell was the inventor, then that fact should have been pleaded in the answer as required by section 4920 of the Revised Statutes, thereby giving us opportunity to prepare to meet it. But this was not done. Campbell's

claim to inventorship was not pleaded in any form whatever; instead thereof Campbell was produced at the trial without any previous notice and testified that he devised and erected the so-called Dunkley machine and was the inventor thereof. It seems apparent that the object of these tactics was to prevent us from preparing beforehand to meet the attack, the intention being to suddenly spring this witness upon us at the trial without any previous warning so as to catch us in a state of unpreparedness. Of course we could have objected to this procedure, but we did not object because our sole desire in the case was to elicit the truth, and we therefore allowed Campbell to tell his story without objection. That story as detailed by him is not worthy of belief and Judge Van Fleet so held.

Briefly stated, the record shows that Campbell prior to the time in controversy had returned from the Klondyke gold fields, where he does not appear to have found any gold, and thereupon entered the electrical business on a small scale at Kalamazoo, he being an electrician. That business does not appear to have been a success, and in 1902 he applied to Mr. Dunkley for employment. Dunkley employed him as an electrician to wire his private residence and later his factory at the small wage of \$60.00 per month. After that work was done he was put to work in the cannery developing a syruping machine and a pitter, both of which were failures

(R. 456). He was neither a carpenter nor a machinist, but appears to have had more or less aptitude for thinking out new ideas. In our opinion he was one of those impracticable mechanical dreamers who never produce any useful results by their own efforts, but claim as their own the results produced by others. Such characters are numerous in the field of invention and they are generally looked upon as half demented. He claims that while in the Dunkley cannery, Mr. Dunkley, without advancing any original ideas, instructed him to build a peach peeling machine, telling him to go to another employee, Mr. Brunker, and get from him the details as to the strength of the lye solution to be used; that in pursuance of these instructions he designed, devised, and built the experimental model machine, plaintiff's Exhibit 10, in the latter part of the peach peeling season of 1903, and thereafter he designed and built a larger machine, and in the fall of 1904 he left the establishment forever, apparently being in high dudgeon with Mr. Dunkley for having refused to give him \$5,000 in money, which he says had been gratuitously promised him. It seems that he came to California in 1905 and has been living in Berkeley ever since.

Not only did he claim to have devised and invented the peach peeling machine for which Mr. Dunkley secured a patent, but he also made a similar claim in respect of all the machines, except one, in-

stalled and used in the Dunkley cannery and for which Mr. Dunkley secured the ten patents which were offered in evidence. He claims to have invented and designed all of these machines out of his own head.

After this case was begun, he allied himself with the defendants and was "employed" by them. Under their directions and at their expense and for the purpose of exploiting the defense he went to Chicago, then to South Haven, then to Kalamazoo, then to Lansing, then to Detroit, and then back home (R. 587). During these excursions he appears to have been accompanied by one of defendants' attorneys. Returning to California he made several visits to Sacramento for the purpose of securing a witness there by the name of Brunker. For his "services" in this case he was paid the sum of \$500.00 in cash and all of his traveling and other expenses (R. 594).

At the trial Judge Van Fleet personally subjected him to a rigid examination, giving him every opportunity to explain the inconsistencies and improbabilities disclosed by his testimony, and afterwards announced that he could not believe him. During the argument, when plaintiff's counsel was arguing against the credibility of his story, the Court interrupted by saying it was not necessary to dwell on Campbell's testimony, because it was too improbable for him to give it any credence (R. 690).

And in his decision of the case the learned Judge said, at page 699 of the Record:

"The main reliance by defendant in the evidence, is upon the testimony of the witness Campbell and that of the witness Brunker. I indicated at the trial, and my mind has been only confirmed in that view by my review of the evidence, that I could not extend the limits of my credulity sufficiently to put credence in the testimony of Campbell. That he worked for the plaintiff at or about the time that he claims, there is no question, but that the claim he puts forth as to what he did in the premises, and the time it was done, is entirely beyond my ability to believe. Brucker tends to corroborate him in certain respects, but it is not sufficient to change my conclusion on the facts."

We sum up Mr. Campbell's character by saying that in our opinion he is a soured, disgruntled, half-demented individual having a personal grudge against Mr. Dunkley and giving his testimony for money.

The witness Brunker was called to corroborate Campbell. He is another witness who was paid for his "services", having received \$35 in that behalf, as admitted in defendant's brief. It appears that in 1903 he solicited employment from Mr. Dunkley for the purpose of making strawberry jam, claiming that he had some mode or process of making the article which would prove remunerative. He was employed for that purpose, but the jam business proved a failure and was abandoned. He seems to

have hung around the cannery in the character of a general utility man until the fall of 1903, at which time he was paid \$200.00, besides some amounts which he had drawn during the interval, for his services of four or five months. He then left the employment of plaintiff and ultimately found his way to California, where he first served as a cook in a restaurant at Sacramento and later purchased a restaurant, which he has since been running as proprietor (R. 614).

He was an intimate friend of Stewart Campbell, and the two were roommates at Kalamazoo. He says that Mr. Dunkley instructed him to experiment with lye in order to discover the proper strength for its use in the contemplated peach-peeling machine, telling him to report results to Campbell, who was to build the machine; that he did report to Campbell and Campbell built the machine in the summer of 1903.

When he was asked in court to point out the machine referred to, he pointed out the wrong machine. At that time plaintiff's exhibit 10 and another peach-peeling machine were on exhibition in Court, and on looking around the room his eye fell upon the wrong machine and he promptly pointed to that machine as the one which Stewart Campbell built in 1903 (R. 69).⁶⁹¹

And in giving his testimony he showed repeatedly that he had a poor memory. For instance, after

.having testified that he went to South Haven at a certain time, he was shown a letter written from New York which indicated that he could not have been at South Haven at the time stated, and in explaining the matter he said that the letter produced surprised him very much, because he thought he had left New York earlier than that, and now he does not think he could have been at South Haven at the time originally testified to by him (R. 610-11).

Again, when he was asked regarding certain dates, he said (R. 629) :

"A. You see, I can't remember about the dates; I can't give you any dates at all; the only dates I have tried to give you have been all wrong."

And yet this man's testimony is relied on for proving facts beyond a reasonable doubt. Our theory in regard to Mr. Brunker is that he is another disgruntled, disappointed, and unsuccessful man, an intimate pal of Stewart Campbell, and between the two of them they have framed up the story that Campbell was the inventor of the machine. It is possible that they assisted in building a peach peeling machine in August, 1903, because Dunkey says he built a second machine about that time, and if they worked on any machine it was probably this second machine. That is the most charitable view to take of their testimony; but that Campbell invented,

designed and built in August, 1903, the machine which Schau and the two Dunkleys say was built in the fall of 1902 is unbelievable.

Mr. Mapes was the third of the trio of witnesses called by defendants. He was a mechanic of Kalamazoo, and for years was doing machinery work for Mr. Dunkley, and while so working filed an application in the Patent Office for a patent on one of the Dunkley inventions whereby an interference was declared which resulted in favor of Mr. Dunkley. Thereafter, Dunkley gave no more machine work to Mapes. These facts serve to explain Mr. Mapes' attitude in this controversy. He produced a book showing machinery work done for Dunkley during 1903, and the contention of defendants is that this work was done on the model machine exhibit No. 10. It is to be remembered, however, that in the latter part of the season of 1903 plaintiff built a larger machine, and so far as these entries are concerned they may as well have referred to this second machine as to the first one. That is to say, there is nothing on the face of the entries themselves to show that they refer to the first machine. His testimony does not negative anything that happened in 1902, nor does it support the testimony of either Campbell or Brunker. It merely shows that he did machine work for Dunkley in 1903 on a machine of some kind, but does not identify the machine. Inasmuch as Mapes had been doing machine work

for Dunkley years prior thereto, it is highly probable that he did do this machine work in 1903, for that was before the episode of the interference and before Dunkley had ceased to patronize his shop; but it does not follow that this machine work was for the plaintiff's exhibit No. 10. If it was done at all, we assert that it was done for some other machine.

It appears that Mr. Mapes was not paid in cash for his "services" in this suit; but it does appear that he came from Kalamazoo to California for the purpose of testifying in this case in order to get a trip to California and was paid all of his "expenses." It does not appear what those "expenses" were, it being left merely to inference that they were of the legitimate kind.

Those three witnesses, Campbell, Brunker, and Mapes, were the only witnesses produced by defendants in respect of the matter now under consideration. Our contention is that all three of them are soreheads having a grudge against Mr. Dunkley, and are now trying to get even; that they embarked in this lawsuit from sordid motives, two of them for payment in cash, and the third for a trip to California from Kalamazoo.

On the other hand, we have the testimony of the two Dunkleys and Schau, the original machine, Exhibit No. 10, the Clark letter fixing the date of the lye tank, the issuance of the patent to Dunkley, the fierce contest of ten years through the Patent Office

where Dunkley was adjudged to be the first and original inventor, the extraordinary diligence of Dunkley in adapting and perfecting his invention and introducing it into public use, failure of Campbell to apply for a patent or even assert any claim to the invention until this controversy arose in 1915, coupled with his acceptance of a large cash consideration from the defendants. It is not to be wondered at that Judge Van Fleet found Dunkley to be the true and original inventor.

DEFENSE OF SURREPTITIOUS PATENTING.

This defense begins at page 35 of defendant's brief, and is in substance that Duhkley surreptitiously obtained the invention from Grier and patented it as his own invention.

Section 4920 of the Revised Statutes provides for such a defense, where it alleges that a defendant may prove:

"That he (the patentee) had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same."

The substance of this defense is that Dunkley was not an inventor at all, but that Grier was the inventor, and that Dunkley in some way or other acquired knowledge of the Grier invention and surreptitiously

or unjustly appropriated the same and secured a patent therefor in his own name and as his own invention, while Grier was using reasonable diligence in adapting and perfecting the same. Of such a defense *Walker on Patents* says in Section 451:

"Such a patent is surreptitiously obtained where the patentee appropriates the idea from the first conceiver, and, exceeding him in speed, reduces the invention to proper form, and secures the patent, while the first conceiver is diligently laboring to adapt the invention to use."

The word "surreptitiously" means secretly, fraudulently, clandestinely, stealthily. Consequently, in order to maintain this defense the defendants must show some such factor.

There is no showing here that Dunkley was guilty of any such conduct. It is not even claimed or pretended that he obtained knowledge of the invention from Grier or from the Grier use. Indeed no such contention could be made because Grier resided in Los Angeles and Dunkley in Kalamazoo, some three thousand miles apart, and Dunkley did not know of the existence of such a man as Grier. The contention, therefore, that Dunkley secretly acquired knowledge of the invention from Grier and *surreptitiously* obtained a patent for Grier's invention is too preposterous for consideration.

It may be that in putting forward this defense defendants intended merely to contend that although

Dunkley was an independent inventor, nevertheless Grier was the prior inventor and was using reasonable diligence in adapting and perfecting his invention. If that is the contention, then it cannot be made under the statutory defense we are now considering.

We contend that the question of relative diligence does not arise in this case, because Grier never applied for a patent. That matter has been treated by my associate. But even if the question were a proper one for consideration, only one conclusion could be reached, viz., that Dunkley's diligence was superior to that of Grier.

Their respective operations appear to have been very nearly contemporaneous, and of course if they were merely contemporaneous, Dunkley must prevail, because Grier never applied for a patent.

Plaintiff's testimony shows that Dunkley conceived the invention in the summer of 1902; made an experimental model, but without a lye tank, in the late summer or early fall of 1902; experimented with that model to his entire satisfaction and determined to build a complete machine for the next season; in April, 1903, purchased a lye tank to be used in connection with the experimental machine; on or about July 15, 1903, coupled up the lye tank with the machine so as to complete it ready for operations; immediately thereafter began to use the machine on early Georgia peaches with success; continued to use that machine during the peach season of 1903; finding

that machine insufficient as to capacity, built another machine in the summer of 1903, a complete operative structure on a larger scale, and used it for the remainder of the peach season of 1903; in 1904 built more of the machines; in November, 1904, applied for his patent; in 1905 built more machines, some of which were sent to Chico, California, and ever since then has been building machines, and has large numbers of them scattered throughout the country; prosecuted his application for a patent in the Patent Office for ten years in the face of fierce opposition; was in interference with a rival inventor; had hearings in all of the tribunals of the Patent Office and finally secured a decision by the Court of Appeals of the District of Columbia in his favor in January, 1913; secured the issuance of his patent in July, 1914; shortly thereafter commenced these eight suits now before the Court; had a trial of the cases in open Court for six days, where large numbers of witnesses were examined, secured an interlocutory decree in his favor, and is now before this Court on appeal.

Now let us review Mr. Grier's record. Giving to his testimony the utmost that can be reasonably claimed for it, even by himself, it would appear that he conceived the invention in the summer of 1902; that in April, 1903, he began the building of two machines; that on July 28th or 29th, 1903, the two machines were tested; that the tests showed

them to be deficient in certain particulars, which were afterwards remedied; that in August, 1903, one of them proved deficient by reason of want of water pressure and on August 3d a pump was purchased for the purpose of increasing the same; that thereafter, during the peach season of 1903, these two machines were used; that in the year 1904 two other similar machines were built, one going to Anaheim and the other to Pomona; that the Anaheim machine was used until 1913, when it was destroyed by fire; that the Pomona machine was used for a year or two and then abandoned (R. 316); that he never applied for a patent on the invention, although he secured patents on several other inventions in the fruit canning art; that after the issuance of the Dunkley patent, in 1914, when he was notified by plaintiff of infringement, he discontinued the use of his machine at Pasadena and dismantled it; that thereafter he immediately proceeded to devise a new machine for *washing* peaches without the use of sprays, for which he promptly obtained a patent; that he has continued to use this *washing* machine to the present time.

It requires no argument to show from the foregoing record that Dunkley is entitled to the award of superior diligence. If, therefore, the matter is reduced to a contest between Dunkley and Grier as to reasonable diligence, which seems to be a point urged by defendants in their brief, then the

decision must be in Dunkley's favor. Dunkley has exhibited unusual diligence, extending over a period from the date of his initial conception in 1902 to the issuance of this patent in 1914, a period of twelve years; whereas Grier has not only failed to show such reasonable diligence, but has been slothful and negligent. If he ever had any rights he has slept on them. Had he filed his application for a patent, he would have been thrown into interference with Dunkley, just as Beekhuis was, and the matter could have then and there been settled. On the contrary, he goes to sleep for twelve years and then suddenly awakes and claims rights of invention superior to those of Dunkley.

AS TO THE ALLEGED FRESNO PRIOR USE.

This can be easily disposed of. It is true that a machine was installed and used at Fresno by the California Fruit Canners' Association in 1902. It was designed, erected, and used under the supervision of a man named Vernon. Hence it is called the Vernon machine. That machine operated on a different principle from Dunkley's. It was adapted from the old orange washing and scrubbing machine which had been used for many years in Southern California to scrape the dirt from the surface of oranges. It conveyed the fruit between a pair of rotary brushes at a very slow rate of speed, which

gave sufficient time for a thorough scrubbing. A water pipe was arranged to supply water, which we say was for the purpose of moistening the brushes so as to reduce their harshness and also to moisten the dirt on the fruit so as to make it more easily removable. We claim that there was no peeling by water jets or sprays, and the dimensions of the pipes sustain this contention. That the water used was insufficient to produce peeling jets is proven by the fact that in 1904 a pump was put in for the purpose of creating such water pressure as to produce sprays for peeling peaches, and also by the fact that when the California Fruit Canners' Association undertook to duplicate this machine at their other canneries during the succeeding year, under the supervision of Mr. Beekhuis, they put in peeling jets and sprays. It would appear from the facts to be a logical conclusion that the Fresno machine of 1902 did not utilize peeling jets, but peeled the fruit on the scrubbing principle, and that in the next year Beekhuis, noting the defect, conceived the idea of using peeling jets, which he introduced in the subsequent machines for the California Canners, and he applied for a patent thereon. But the interference case decided that Dunkley's invention was prior to Beekhuis.

And finally, Vernon himself, though dead, left conclusive evidence in our favor. He designed, devised, and constructed the Fresno machine, and, therefore,

he ought to be the person best qualified to describe it. After designing and constructing said machine he immediately proceeded to apply for a patent thereon. The application is dated November 22, 1902, and the patent was issued March 7, 1905. It appears at pages 742-4 of the record, where a drawing of the machine is shown and a description of its construction is given. *It shows no peeling jets or sprays of any kind whatever*, but shows a machine operated on the scrubbing principle as we have heretofore described it. It is there designated as a "brushing machine", and its mode of operation is to brush the skin of the fruit. In passing upon this issue the Judge of the Lower Court says (R. 697):

"As to the Vernon device, it had been in use in Fresno as early as 1902 or 1903. I am unable to hold that that device was an anticipation in its essential characteristics. It operated upon a fundamentally different principle. That was an adaptation to the purposes for which the plaintiff's device was used, that of peeling peaches, of a device by Baker and another for scouring oranges for the market; it had a system of revolving brushes, and it used a saturation or douche of water for the purpose of softening the brushes and of washing the fruit; but the essential operative principle there was the brushes. They were for the purpose of scrubbing and washing the hard outer surface of the skin of the orange and of freeing it from mould and other detrimental substances which interfered with its marketability, and the essential principle was the operation of

the brushes. The water was used, as I have suggested, only for a saturating and washing purpose. I may say, furthermore, that the patent itself did not call for the essential feature which I find characterizes the plaintiff's device, that is, of peeling jets of water, or water admitted at such a high pressure upon the fruit as to act itself as the primary means of washing the skin from the fruit; nor do I think that the manner in which the Vernon patent was used was such as to suggest readily to the mind the idea that peeling jets of water would be efficient for the purpose for which the plaintiff's device was intended. The plaintiff's device operates upon quite a different principle. It has the rotating brushes, but has these peeling jets of water, which are themselves the efficient means of washing off the disintegrated skin of the peach after it has been put through the lye process, and the brushes serve the subsidiary purpose of agitating the fruit and of turning it for the purpose of presenting its different surfaces to the jets of water to enable them to do the efficient work of cleansing the skin after its disintegration by the lye bath; and I am therefore unable to hold that the Vernon device, which was subsequently patented—I think in 1905—can be regarded as an anticipation of the device or the conception embodied in the plaintiff's patent."

DEFENSE OF UNCLEAN HANDS.

The gist of this defense is stated to be that the plaintiff knew of the two years' prior use at Fresno, and for the purpose of making it as difficult as

possible for any defendant who might be sued to prove such use in an infringement suit, plaintiff issued a free license to the California Fruit Canners' Association, coupled with an agreement that said association should align itself with the plaintiff and put obstacles in the way of any one attempting to prove such prior use.

The only true fact in this indictment is the issuance of a free license to the California Fruit Canners' Association. The record does not show the reason for issuing such license, and the defendant only assumes that it was for the purpose charged. There may have been good business reasons for issuing that license at the time in question (May 22, 1914), in view of the fact that said association was a large and well-known dealer in canned goods. Surely a patentee has a right to issue licenses under his patent upon such terms as he sees fit.

Now as to the other portion of this defense, that the license was coupled with an agreement to put obstacles in the way of anyone attempting to prove the alleged prior use, the defendants called as a witness ROBERT I. BENTLEY, the general manager of the California Fruit Canners' Association, who testified that there was no such agreement (R. 226). No other evidence was introduced on the subject, and this defense of unclean hands then and there collapsed, and was not afterwards heard of. It appears

to have been a mere surmise and conjecture on the part of defendant's counsel which failed of realization. Indeed, it does not appear to be insisted on in defendant's brief, though it is formally stated at page 13.

We submit that Justice was done by the Lower Court and that its decree should be affirmed.

Respectfully submitted.

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